

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed December 9, 2004. Applicant appreciates the Examiner's consideration of the Application. Claims 1, 3-15, and 17-37 currently stand rejected.

Specification Objections

The Examiner made several objections to the specification. The appropriate corrections have been made, according to the Examiner's instructions. Accordingly, Applicant requests removal of these objections.

Section 103(a) Rejection

Claims 1, 4-15, and 18-37 were rejected under U.S.C. § 103(a) as being unpatentable over "Managing by Projects" by LeRouge ("*LeRouge*") in view of "A Stakeholder Approach to Strategic Performance Measurement" by Atkinson et al. ("*Atkinson*"). Applicant respectfully traverses this rejection. Applicant submits that *LeRouge* and *Atkinson*, even when combined, do not disclose, teach, or suggest, at least the following limitations of independent Claim 1:

displaying a contract template on a website; and

receiving a contract generated from the contract template displayed on the website, the contract specifying an agreement between an organization and a project owner employed by the organization, the agreement made by the project owner to *take responsibility* for implementing a project according to a schedule

(Emphasis added.)

At the outset, Applicant notes that the Office Action makes no reference to the former of the above limitations: displaying a contract template on a website. With regards to the latter of the above limitations, the Office Action concedes that *LeRouge* does not explicitly disclose the above limitation. (Office Action, Page 4.) The Office Action, however, attempts a constructive disclosure of this limitation in the following manner:

LeRouge does discuss to the use of contract management (e.g., p.73, c.3), detailed employee and project information to determine resource allocation across projects and the use of project software tools to store and retrieve project information (p.71, c.1). Le Rouge also discloses management of a project schedule (timeline, on-time performance, e.g., p.70, c.1; p.76, c.2); and

templates (work breakdown templates, e.g., p.71, c.3) for various project components. Generally, templates are used to generate information that is complete and consistent. How the information is used in LeRouge is what classifies it as a contract between the project owner (project manager) and the organization (management).

(Office Action, Page 4.)

Atkinson et al. disclose the use of an employment contract (performance measurement) to test and manage the relationship between the employee and the organization. Performance measurement includes monitoring and reporting performance in terms of implementation of organization plans (p. 30 c. 1, p. 31, c.1).

(Office Action, Page 4.)

Each of the above referenced portions cited in the Office Action recite the following:

Provide contract management capabilities such as document control, change order updates contract records.

(*LeRouge*, Page 73, Column 3, this recitation is a bulleted item from page 72.)

Strategic Resource Allocation. In many technologically advanced industries, the availability of skilled labor has become a critical constraint because resources are scarce and geographically dispersed. With detailed employee and project information resources (both human and material) can be allocated more efficiently across projects.

(*LeRouge*, Page 71, Column 1.)

Unlike traditional manufacturing processes or retained time services, projects are temporary and have defined budgets and time schedules.

(*LeRouge*, Page 70, Column 1.)

Most packages provide features that let users review project manager or department manager on time and on-budget performance, and many also offer features aimed at human resource planning.

(*LeRouge*, Page 76, Column 2.)

Management may identify guidelines associated with “deliverables” for this phase that reflect the successful organization of activities of similar previous projects or amended strategies. The work breakdown templates direct the project manager in assigning costs, labor resources, projected revenues, material resources, time duration, and other project components.

(*LeRouge*, Page 71, Column 3.)

With performance measurement, an organization can monitor the implementation of its plan and determine when plans are unsuccessful and how to improve them.

(*Atkinson*, Page 30, Column 1.)

In performance measurement's *monitoring* role, it measures and reports performance in meeting stakeholder requirements.

(*Atkinson*, Page 31, Column 1.)

Applicant respectfully submits that these recitations do not disclose any contract specifying an agreement between an organization and a project owner employed by the organization, much less an agreement made by the project owner to take *responsibility* for the implementation of the project. For at least this reason, Applicant submits that Claim 1 is allowable.

As the Examiner is aware, the establishment of a *prima facie case* of obviousness utilizing a combination of references requires a *motivation to combine* features extracted from such references. Assuming for the sake of argument that *LeRouge* and *Atkinson*, when combined, disclose each and every element of the invention defined by Claim 1 (which they do not), Applicant questions the Examiner's alleged motivation to combine features from such references. The following was indicated in the Office Action as a motivation to combine *LeRouge* and *Atkinson*:

It would have been obvious to modify *LeRouge* as taught by *Atkinson et al.* to include a contract or agreement between the project owner (project manager) and the organization in order to reinforce the importance of performance and to measure the employee performance against the objectives of a particular project. In the method and system of *LeRouge* as modified by *Atkinson*, the work breakdown template sets forth the schedule and budget that the project manager will meet throughout the project, i.e., a type of contract.

(Office Action, Page 5.)

In this case, *LeRouge* discloses a software application to manage contracts. *Atkinson* teaches a contract between an organization and

an employee of the organization. The suggestion to combine the references is found in the knowledge generally available to one of ordinary skill in the art, as discussed above in more detail, and that such a person would have found it obvious to use the software application of LeRouge to manage any type of contract.

(Office Action, Page 8.)

The above alleged motivation is simply hindsight reconstruction. Such reasoning falls well short of providing the required evidence of a motivation to combine the prior art references. Hence, the Examiner has not established a *prima facie* case of obviousness.

The fact that a prior art device could be modified so as to produce the claimed invention is not a basis for an obviousness rejection unless the *prior art suggested the desirability of such a modification*. In *re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). The Examiner is reminded that "[t]he factual inquiry whether to combine references must be thorough and searching." In *re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002).. And "[an] examiners conclusory statements . . . do not adequately address the issue of motivation to combine." *Id.* The Examiner is further reminded that "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (emphasis added) In *re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986) (emphasis added) .

With the above in mind, Applicant submits that the Examiner has "picked" features from *LeRouge* and *Atkinson* to the exclusion of what each reference teaches. For example, the Examiner is choosing to exclude the following teachings of *Atkinson*:

Not only do implicit contracts offer the potential for developing high-quality, lower cost products, but when the conditions are right for implicit contracting (that is, there is a basis for trust), implicit contracts can *eliminate or at least reduce the significant transaction costs relating to finding partners, writing contracts, and monitoring compliance*.

(Page 29, Column 2.)

Without the Applicant's disclosure in hand, one of ordinary skill in the art would not provide a method that includes receiving a contract generated from the contract template

displayed on the website, the contract specifying an agreement between an organization and a project owner employed by the organization, the agreement made by the project owner to *take responsibility* for implementing a project according to a schedule in combination with the other limitations of Claim 1. For at least this additional reason, Applicant believes that Claim 1 is allowable.

The Examiner in setting forth the above alleged motivation makes no citation to any particular reference. Accordingly, if the Examiner is relying upon “common knowledge” or “well known” principles to supply the required motivation or suggestion to modify the references, Applicant respectfully requests that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. Alternatively, if the Examiner’s personal knowledge is being relied on to supply the required motivation or suggestion to modify, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03 and 37 C.F.R. 1.104(d)(2).

Applicant additionally requests references for the rejections based on official notices, “common knowledge” or “well known” principles pursuant to M.P.E.P. § 2144.03. If the Examiner’s personal knowledge is being relied on to provide the basis for these rejections, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03 and 37 C.F.R. 1.104(d)(2).

Independent Claims 15 and 29 recite certain limitations that are similar, although not identical, to limitations of Claim 1. Therefore, Claims 15 and 29 are allowable over the cited references for analogous reasons.

Applicant's dependent Claims 3-14, 17-28, and 30-37 are allowable based on their dependence on independent Claims 1, 15, and 29 and further because they recite numerous additional patentable distinctions over the cited reference of the rejection. Accordingly, Applicant respectfully requests reconsideration and allowance of Claims 1, 4-15, and 18-37 under 35.

Claims 3 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *LeRouge* and *Atkinson* as applied to claims 1 and 15, respectively, above, and further in view of “Digital Signatures: Signing and Notarizing Electronic Forms” by Theofanos, et al (*Theofanos*). Applicant traverses this rejection. The following was indicated in the Office Action, as a motivation to combine *LeRouge*, *Atkinson*, and *Theofanos*:

It would have been obvious to one of ordinary skill in the art to modify the method and system of LeRouge to include the use of electronic signatures for the contract or agreement between the organization and project owner, as taught by Theofanos et al., in order to increase the trustworthiness and to protect the authenticity and security of the contract or agreement between the organization and the project owner for every project.

(Office Action, page 7.) Such a statement is simply an engagement of hindsight reconstruction. In setting forth the rejection of Claims 3 and 17, the Examiner is utilizing the application as blueprint to organize features from three separate references, one of which discloses that “implicit contracts can *eliminate or at least reduce the significant transaction costs relating to finding partners, writing contracts, and monitoring compliance.*” (Atkinson Page 29, Column 2.) Such a blueprint must come from the references, not from the Applicant’s disclosure. For at least this additional reason, Claims 3 and 17 are allowable over the cited references.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all the pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Keiko Ichiye, the Attorney for Applicant, at the Examiner's convenience at (214) 953-6494.

Applicant believes no fee is due. However, if this is not correct, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,

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